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09/966,884	09/28/2001	Anthony J. Baerlocher	0112300-482	5171

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EXAMINER	
MARKS, CHRISTINA M	
ART UNIT	**PAPER NUMBER**
3713	5

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N,K

Office Action Summary	Application No.	Applicant(s)	
	09/966,884	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7, 23, 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 25, 28, 30 and 47 of U.S. Patent No. 6,506,118. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the patent disclose that which is being claimed in the cited claims of the Application. The claims both include a processor, a first set of offers, a second set of offers, means in which the second set is bet based upon an element of the first set and means for the player to control an acceptance or rejection of the offer.

Claims 2 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 28, 30 and 47 of U.S. Patent No. 6,506,118. Although the conflicting claims are not identical, they are not patentably distinct from each other because the new offer is formed based upon an addition factor associated with a previous offer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 and those dependent therefrom, the first set of potential offers is not positively linked to the structure claimed. The first set of potential offers is a free floating entity of the gaming machine as opposed to the second set of offers that is positively connected to the processor. Applicant lacks required elements or structure to clearly delineate the manner in which there is a relation between the offer sets. Further, Applicant does not state whether a processor/controller presents the first potential offer, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the first offer is established and therefore one of ordinary skill in the art would not be able to ascertain the function of the first set of potential offers and how they are used to affect the second set of offers as they are not embodied within the machine and are therefore not linked to the process.

Regarding claim 7 and those dependent therefrom, the first set of potential offers and the second set of potential offers are not positively linked to the structure claimed. The first and second sets of potential offers are free floating entities of the gaming machine. Applicant lacks required elements or structure to clearly delineate the manner in which there is a relation between the offer sets. Further, Applicant does not state whether a processor/controller presents

the first and second potential offers, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the first and second offers are established and therefore one of ordinary skill in the art would not be able to ascertain the function of the first set of potential offers and how they are used to affect the second set of offers as neither offer is embodied within the machine and are therefore not linked to the process.

Regarding claim 16 and those dependent therefrom, the first set of potential offers and the second set of potential offers is not positively linked to the structure claimed. The first and second sets of potential offers are free floating entities of the gaming machine. Applicant lacks required elements or structure to clearly delineate the manner in which there is a relation between the offer sets. Further, Applicant does not state whether a processor/controller presents the first and second potential offers, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the first and second offers are established and therefore one of ordinary skill in the art would not be able to ascertain the function of the first set of potential offers and how they are used to affect the second set of offers as neither offer is embodied within the machine and are therefore not linked to the process. Further, the potential terminator also lacks a positive connection between the elements of the game in the same manner as disclosed in relation to the offers above.

Claim 23 and those dependent therefrom recites the limitation "said other values" in line 8. There is insufficient antecedent basis for this limitation in the claim. There is no previous support for the term “other values” and therefore one of ordinary skill in the art would not understand what the language is claiming. Further, one of ordinary skill in the art would not

understand what the language means in relation to the changing of the value and how it affect the offer to the player (lines 6-9).

Regarding claim 24, there is insufficient antecedent basis for the term "the value providing means."

Regarding claim 25, there is insufficient antecedent basis for the term "the generation device."

Regarding claim 26-28, there is insufficient antecedent basis for the term "the value changing means."

Regarding claims 36, 43, 44, and 47, one of ordinary skill in the art would not understand what generation and regeneration mean as there is not adequate requisite support or basis for the terms in the claims or the parent claims.

Regarding claim 42, there is insufficient antecedent basis for the term "the offer." There are number of different types of offers disclosed prior and one of ordinary skill in the art would not understand which offer is being referred to.

Regarding claim 29 and those dependent therefrom, the path and the offers are not positively linked to the structure claimed. The path and the offer are free floating entities of the gaming machine. Applicant lacks required elements or structure to clearly delineate the manner in which there is a relation between the path and the offer. Further, Applicant does not state whether a processor/controller presents the path and the offer, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the path and the offer are established and therefore one of ordinary skill in the art would not be able to

ascertain the function of the path and how it is used to affect the offers as neither is embodied within the machine and are therefore not linked to the process.

Regarding claim 38 and those dependent therefrom, the plurality of potential offers are not positively linked to the structure claimed. The plurality of potential offers is a free floating entities of the gaming machine. Applicant lacks required elements or structure to clearly delineate the manner in which there is a relation between the offer sets. Further, Applicant does not state whether a processor/controller presents plurality of offers, as such, there lacks a positive connection between elements of the game. A manner has not be set forth is which the plurality of offers are established and therefore one of ordinary skill in the art would not be able to ascertain the function of the previous offers and how they are used to affect the current offers as neither offer is embodied within the machine and are therefore not linked to the process.

For examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 7-10, 12-13, 23-26, 29-32 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by S-Plus Limited: Take Your Pick.

Take Your Pick discloses a gaming device that inherently comprises a processor. The gaming device presents the player with a first potential offer (result of the first bonus presented) and if the player chooses to reject that offer, a second offer is determined based on part by the first offer in that the player can as part of their rejection of the first offer hold part of the first offer for application to the second offer. Thus, the second offer is based upon the first offer in that it still holds in common a mathematical variable for computation of the final offer. The gaming device also includes a display and means for the player to reject or accept the first offer.

Regarding claims 2 and 8, the gaming device allows the player to hold over a factor of the award; therefore, any subsequent second offer will be based on the first offer made if the player rejects the entire first offer.

Regarding claim 5, the gaming device also allows the player to perform the same functionality for a third offer. Thus a player can reject a second offer and then be presented a third offer based upon in part the rejected second offer.

Regarding claims 9 and 10, the gaming device includes a second offer provided to the player that is from the plurality of second potential offers and is based in part, as discussed above, on the first offer that is provided to the player.

Regarding claims 12 and 13, the second offer will replace the first offer if the player chooses not to accept the first offer.

Regarding claim 24, the values are inherently produced in part by a random generation means.

Regarding claim 25, the generation device is discloses as a number appearing on an indicator.

Regarding claim 26, the value changing means includes the means of increasing the award offered to the player.

Regarding claim 29, the presentation of the offers is that of the form of a path (see FIG) with a plurality of positions.

Regarding claim 30, this path is enclosed within two circles wherein with respect to claims 31 and 32, each position displays an offer.

Claims 1, 7, 23 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooker (US Patent No. 4,184,683).

Hooker discloses a gaming device that has three wheels and inherently possesses a processor to control the random rotation of the wheels (Column 1, lines 10-15). The wheels are spun and the player is offered the prize associated with the result (Abstract). If the player chooses to not accept that prize (such as if it were equal to zero), the option is presented wherein the player can hold a number of the symbols in order to then be offered with a second offer that is based in part on the first offer due to the symbol that is held over (FIG 1). The gaming device has a display (FIG 1) and means for the player to accept and reject the result on the wheels (FIG 1, reference 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 11, 27-28, 34, and 39-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over S-Plus Limited: Take Your Pick.

What Take Your Pick discloses has been discussed above and is incorporated herein.

Regarding claims 3, 11, 39, and 52, in application of the second offer, the player is now only spinning one reel; therefore, the second set of offers comprises only the numbers listed on the non-selected reel wherein the first set included the first reel. Take Your Pick discloses that the second offer is mathematically related to the first offer as a multiplicative relation and the processor controls the result. Therefore, each potential offer of the second set is determined with a mathematical relation to the first set (in the disclosed embodiment it is a multiplicative relationship). It would there be obvious and well within the understanding of one of ordinary skill in the art to be able to control the type of set to mathematically represent any design choice preferred. Thus, the inclusion of the second set of offers being additive relations as opposed to multiplicative relations would have been obvious to one of ordinary skill in the art based upon the disclosure of Take Your Pick.

Regarding claims 27, 28, and 34, it would be well within the skill of one of ordinary skill in the art to allow the device to change the value based on increasing the values not previously offered or chosen. The manner in which the values are changed, determined, and presented is a design choice and it would be obvious to one of ordinary skill in the art to adapt the values in view of the disclosure of Take Your Pick.

Regarding claim 40, the offer includes a multiplication value to a previously displayed offer (that which is remaining by the player choice). Though Take Your Pick does not include a multiplicative of the entire first offer, one of ordinary skill in the art would understand that this could be easily accomplished based upon the disclosure of Take Your Pick and as discussed above would be a design choice as per the preference of one of ordinary skill in the art as to how the sets should be related.

Regarding claim 45, the device of Take Your Pick includes a method by operation of the device that includes displaying a plurality of potential offers, generating a first offer, that changes the potential values of the remaining offers. The player is then enabled to accept or reject the provided offer and if the player rejects the offer, generating a second offer that has not been previously generated (rejected offer goes dark as the second offer lights up).

Regarding claim 48, the player is awarded the first offer if the player accepts the first offer and likewise, regarding claim 49, the player is awarded the second offer if the player accepts the second offer.

Regarding claim 50, the display device includes a path with a plurality of positions and regarding claims 51; the generation of the offers axiomatically includes generating positions along the path as the selected positions are highlighted.

Regarding claim 53, the offer includes a multiplication value to a previously displayed offer (that which is remaining by the player choice). Though Take Your Pick does not include a multiplicative of the entire first offer, one of ordinary skill in the art would understand that this could be easily accomplished based upon the disclosure of Take Your Pick and as discussed above would be a design choice as per the preference of one of ordinary skill in the art as to how the sets should be related.

Regarding claims 36, 37, 41-44 and 46-47, it is notoriously well known in the art to offer a consolation prize to players in a bonus environment to assure a prize is won. It is known that upon a terminator symbol, players are often given a consolidation award based upon how far they were in the bonus round so they will still receive a bonus even if they "lost" the bonus round. The means in which the consolation prize is awarded, calculated, supplemented, or shown would be easily conceived, altered and designed by one of ordinary skill in the art and thus would be obvious design choices to a skilled artisan in relation to incorporating a terminator and compensating a player for the bonus.

Claims 4, 6, 14-22, 33 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over S-Plus Limited: Take Your Pick in view of Baerlocher et al. (US Patent No. 6,506,118).

What S-Plus Limited: Take Your Pick discloses, teaches, and/or suggests has been discussed above and is incorporated herein.

Take Your Pick discloses that the part of the first offer that is rejected becomes darkened out of play in the second offer. Take Your Pick does not disclose that it becomes a terminator.

It is notoriously well known in the art to use terminators to end a bonus round. This would have been obvious to the system of Take Your Pick to one of ordinary skill in the art. One of ordinary skill in the art would understand that instead of setting a number of spins for a player, a terminator could be used to limit the time on the bonus round and the substitution of such a design choice would have been apparent to a skill artisan. It is obvious to one of ordinary skill in the art and disclosed by Take Your Pick that once a choice has been rejected, it is removed from the system in order to not offer the same prize twice. One of ordinary skill in the art would thus be motivated instead of getting rid of them by darkening, to incorporate them as terminators in order to not limit the player to the number of choices they can make. Thus, the player would feel as if they were in more control regarding the bonus round and would garnish greater excitement from playing knowing that they are not limited to a number of plays, but limited only by their own choices.

This feature is supported by the disclosure of Baerlocher et al. Baerlocher et al. disclose that upon the rejection of an offer, the offer is replaced by a terminator symbol in an offer/acceptance gaming scheme (Column 15, lines 19-45). Further, the gaming device includes other terminators already assigned to the choices (Column 15, lines 19-45). Thus, the positions displaying terminators are positions that had previously displayed and offer that was rejected by the player (Column 15, lines 19-45).

Therefore, based upon what is notoriously well known in the art about terminators and supported by Baerlocher et al., one of ordinary skill in the art would be motivated, as disclosed above, to incorporate terminators into the system of Take Your Pick. By this incorporation,

players would feel a greater sense of excitement and anticipation knowing that their time in the bonus round is not limited by a number of choices, but by their own decisions.

Regarding claims 18, 36, and 37, it is notoriously well known in the art to offer a consolation prize to players in a bonus environment to assure a prize is won. It is known that upon a terminator symbol, players are often given a consolidation award based upon how far they were in the bonus round so they will still receive a bonus even if they "lost" the bonus round. The means in which the consolation prize is awarded, calculated, supplemented, or shown would be easily conceived, altered and designed by one of ordinary skill in the art and thus would be obvious design choices to a skilled artisan in relation to incorporating a terminator and compensating a player for the bonus.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,406,369: Gaming device with a path that has a plurality of bonus offers along it.

US Patent No. 6,413,161: Player can selectively replace awards as they progress through the bonus round.

US Patent No. 6,569,015: Player is given a first offer and can accept or reject it and then receive a second offer based upon the first offer.

US Patent No. 6,375,187: Player can choose a first offer that will directly affect the number of chances available in the second offer.

US Patent No. 6,585,591: Bonus game where previous selection include data from past selections.

US Patent No. 6,595,854: Bonus game wherein selections from a first group are used to incorporate the player into a next group.

US Patent No. 5,997,401: Gaming device wherein an offer can be used to affect further offers.

GB 2 191 030: Gaming device with a plurality of offers associated with one another for further awarding the player.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
August 6, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER